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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,680

03/16/2007

Shigeki Ohno

5404/129

1388

757 7590 06/01/2009  
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EXAMINER

REDDY, KARUNA P

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,680	<b>Applicant(s)</b> OHNO ET AL.	
	<b>Examiner</b> KARUNA P. REDDY	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Note that claim 1 appears in all the groups listed below since it is generic to the claimed curable composition.

- i. Group I, claim(s) 1-3 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable silyl group and surface tack modifier.
- ii. Group II, claim(s) 1-2, 4 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable alkenyl group and surface tack modifier.
- iii. Group III, claim(s) 1-2, 5 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable hydroxyl group and surface tack modifier.
- iv. Group IV, claim(s) 1-2, 6 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable amino group and surface tack modifier.

Art Unit: 1796

- v. Group V, claim(s) 1-2, 7 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable polymerizable C=C bond and surface tack modifier.
  - vi. Group VI, claim(s) 1-2, 8 and 9-25, drawn to curable composition comprising poly(meth)acrylate having at least one crosslinkable epoxy group and surface tack modifier.
2. The inventions listed as Groups I to VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical features that are common to groups I to VI include a curable composition comprising poly(meth)acrylate having at least one crosslinkable functional group and a surface tack modifier having a melting point between 30<sup>0</sup>C and 200<sup>0</sup>C at 1 atm. These features are taught by the prior art of Bandou et al (US 7,135,518 B2). Specifically, attention is drawn to a curable composition comprising (meth)acrylate polymer having a crosslinkable functional group (col. 7, lines 51-54), and composition further comprises at least one compound selected from amide having a melting point of 40 to 75<sup>0</sup>C (col. 3, lines 32-36). Therefore, since the common technical feature of claims belonging to groups I to VI fail to contribute over 7,135,518 B2, they fail to constitute a special technical feature and hence there is lack of unity between the cited groups.
3. Furthermore, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. In

Art Unit: 1796

particular, the surface tack modifier is deemed to be generic and applicant is requested to elect a species for said surface tack modifier.

The species are as follows:

- i. Aliphatic hydrocarbon compound.
- ii. Aliphatic carboxylic acid compound.
- iii. Aliphatic alcohol.
- iv. Aliphatic carboxylic acid ester compound.
- v. Aliphatic carboxylic acid amide compound.
- vi. Natural wax.
- vii. Organic polymer, which itself encompasses the listed species.
  1. polyethylene and polypropylene
  2. polystyrene
  3. polydiallyl phthalate
  4. polycarbonate
  5. polyether
  6. polyester
  7. thermoplastic resin

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

Art Unit: 1796

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. It is noted that no telephone communication was made since the requirement for restriction is complex. See MPEP § 812.01 [R-3].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Art Unit: 1796

Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796